

IN THE DRAWINGS:

To overcome the Office Action's objection of the drawings, Applicants concurrently file herewith a Submission of Replacement Drawings with one (1) sheet of replacement drawings to substitute for the original filed drawing sheets. Figs. 10(a-d) (sheet 10/10) is amended to be labeled as "Related Art". Support for the new label can be found at least at page 1, lines 15-16 and page 6, lines 5-6 of the Applicants' specification as originally filed. No new matter has been added. Applicants respectfully request that the objection to the drawings be removed.

REMARKS

Summary of the Office Action

In the Office Action, the Abstract and drawings are objected to for certain informalities.

Claims 1 and 3 stand rejected under 35 U.S.C. § 112, second paragraph.

Claims 1-3 and 5 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,209,772 to *Wang*.

Claims 1 and 3-4 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,651,491 to *Heaton, et al.*, hereinafter ("*Heaton*").

Summary of the Response to the Office Action

Applicants propose amending the Abstract, drawings, and claims 1 and 3. Accordingly, claims 1-5 are pending for further consideration.

Abstract

The Abstract is amended in accordance with the suggestions in the Office Action. Accordingly, Applicants respectfully request that the objection to the Abstract be removed.

Drawings

To overcome the Office Action's objection of the drawings, Applicants concurrently file a Submission of Formal Drawings with one (1) sheet of formal drawings to substitute the original filed drawing sheets. The new formal drawings amend Figs. 10(a-d) to include the label "Related Art." Applicants respectfully request that the objection to the drawings be removed.

All Subject Matter Complies with 35 U.S.C. § 112, second paragraph

Claims 1 and 3 were rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. Claims 1 and 3 have been amended to correct the errors pointed out by the

Examiner in the March 6, 2006 Office Action. Applicants respectfully submit that this rejection is respectfully traversed in light of the current amendments to claims 1 and 3. Accordingly, it is respectfully requested that all rejections under 35 U.S.C. § 112, second paragraph, be withdrawn.

All Subject Matter Complies with 35 U.S.C. § 102(b)

Claims 1-3 and 5 stand rejected under 35 U.S.C. § 102(b) as being anticipated by *Wang*. Applicants respectfully traverse the rejection for the following reasons.

Applicants respectfully submit that the Office Action has not established that *Wang* anticipates each and every feature of Applicants' claimed invention and that all rejections under 35 U.S.C. § 102(b) should be withdrawn. Namely, Applicants contend that independent claims 1 and 3 recite the features of a "guide member for supporting a side of a base portion of the staple leg from an inner side of the staple during a process that the staple leg of the staple is penetrating the sheets." At least this feature is not disclosed or taught by *Wang*.

Wang discloses a manual stapler that indicates how many staples are left within the stapler when being operated. See *Wang* at col. 1, lines 11-30. However, the manual stapler of *Wang* fails to teach or suggest at least the above feature of claims 1 and 3.

The Office Action states that *Wang* discloses "a guide member (123) for supporting a side of the base portion of the staple leg from an inner side of the stapler during the process that the staple legs penetrate the sheets." Contrary to this assertion, *Wang* discloses a spring plate (12) with a protection plate (123) that operates so that "the staple will be pushed out by the pressing plate 111 and guided by the protection plate 123." See *Wang* at col. 3, lines 1-9. *Wang* does not disclose a "guide member for supporting a side of a base portion of the staple leg from an inner side of the staple during a process that the staple leg of the staple is penetrating the

sheets” as does the present invention. Assuming for the moment the protection plate (123) is a “guide member” as asserted, *Wang* does not disclose that the protection plate supports “a base portion of the staple leg from an inner side of the staple.” In fact as seen in Figs. 5A and 5B, the protecting plate 123 does not even touch a base portion of the staple leg from an inner side of the staple. Because *Wang* does not disclose these features, it cannot anticipate the invention recited in claims 1 and 3.

As pointed out in MPEP § 2131, a claim is anticipated by a prior art reference only if each and every element as set forth in the claim is found. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051 (Fed. Cir. 1987). Therefore, Applicants respectfully assert that the rejections under 35 U.S.C. § 102(b) should be withdrawn because *Wang* does not teach or suggest each feature of independent claims 1 and 3.

Additionally, Applicants respectfully submit that dependent claims 2 and 5 are also allowable insofar as they recite the patentable combinations of features recited in claims 1 and 3, as well as reciting additional features that further distinguish over the applied prior art.

All Subject Matter Complies with 35 U.S.C. § 102(b)

Claims 1 and 3-4 stand rejected under 35 U.S.C. § 102(b) as being anticipated by *Heaton*. Applicants respectfully traverse the rejection for the following reasons.

Applicants respectfully submit that the Office Action has not established that *Heaton* anticipates each and every feature of Applicants’ claimed invention and that all rejections under 35 U.S.C. § 102(b) should be withdrawn. Namely, Applicants contend that independent claims 1 and 3 recite the features of “guide member for supporting a side of a base portion of the staple

leg from an inner side of the staple during a process that the staple leg of the staple is penetrating the sheets.” At least these features are not disclosed or taught by *Heaton*.

Heaton discloses a surgical stapler for applying a plurality of surgical staples to body tissue. See *Heaton* at col. 1, lines 5-8. However, stapler of *Heaton* fails to teach or suggest at least the above features of claims 1 and 3.

The Office Action states that *Heaton* discloses “the guide member (slot walls seen in Fig. 6b, not numbered).” Contrary to this assertion, *Heaton* discloses slots in cartridge 22 (Fig. 6b not numbered) from which staples 24 are ejected. See *Heaton* at col. 5, lines 19-30. *Heaton* does not disclose a guide member that supports a side of a base portion of the staple leg from an inner side of the staple. The slots identified in cartridge 22 cannot support the staple so. Because *Heaton* does not disclose these features, it cannot anticipate the invention recited in claims 1 and 3.

As pointed out in MPEP § 2131, a claim is anticipated by a prior art reference only if each and every element as set forth in the claim is found. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051 (Fed. Cir. 1987). Therefore, Applicants respectfully assert that the rejection under 35 U.S.C. § 102(b) should be withdrawn because *Heaton* does not teach or suggest each feature of independent claims 1 and 3.

Additionally, Applicants respectfully submit that dependent claim 4 is also allowable insofar as it recites the patentable combinations of features recited in claim 3, as well as reciting additional features that further distinguish over the applied prior art.

CONCLUSION

In view of the foregoing, Applicants respectfully request reconsideration and the timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of the Response, the Examiner is invited to contact the Applicants' undersigned representative to expedite prosecution.

EXCEPT for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account No. 50-0310. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

MORGAN, LEWIS & BOCKIUS LLP

Dated: June 6, 2006

By: _____



David B. Hardy
Reg. No. 47,362

CUSTOMER NO. 009629
MORGAN, LEWIS & BOCKIUS LLP
1111 Pennsylvania Avenue, N.W.
Washington, D.C. 20004
Tel: 202-739-3000
Fax: 202-739-3100